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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,686	08/16/2001	Stephan Appen	MUH-11671	3318
24131	7590	07/14/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			PATEL, PARESH H	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/931,686

Applicant(s)

APPEN ET AL.

Examiner

Paresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments filed 04/26/2004 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "An apparatus for automated testing, **calibrating ... for semiconductor devices**" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant also argues, that "no circuit board is tested" according to instant application. Rather, the invention serves for testing of test adapters, which will later be used to test circuit. Examiner disagrees with applicant because reasonably broad interpretation of test adapter (as claimed) reads on circuit board 2 or PCB of Nishikawa reference. Also, the subject matter "which will later be used to test circuit" is not found in the claim.

Applicant later argues that Nishikawa et al. also do not show "a holder for holding a test adapter" and "contact pins **for testing said test adapter**" as recited in claim 1. Examiner respectfully disagrees with applicant because Nishikawa et al. in fig. 12-13

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discloses holder (5, 6, 51) for holding test adapter (circuit board 2 of Nishikawa et al.) and contact pins (142A-B) for testing said test adapter (2).

### ***Election/Restrictions***

This application contains claim 13 drawn to an invention nonelected with traverse in the reply filed on 05/05/2003. Newly added claim 20 also reads on nonelected species fig. 7 (see last paragraph on page 11 under applicants remarks of 04/26/2004). A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Newly submitted claim 20 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: 1) nonelected species of fig. 7 [see office action (restriction) of 03/6/03 and response (election) of 05/05/03] claimed, and 2) test adapter having contact surface and **contact needles opposite said contact surface and contacts pins of probe head being adapted to be in contact with said contact needles** as further claimed were not examined earlier.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 20 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 8, 10 and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishikawa (US 6356093).

Regarding claim 1, Nishikawa discloses: An apparatus for automated testing [fig. 12-13], calibration and characterization of test adapters for semiconductor devices, comprising:

a holder [5, 6, 51] for holding a test adapter [2 or PCB];

at least one probe head [141A-B of 4U] adjustably disposed relative to said holder, said probe head having at least two contact pins [142 of 141A-B] for testing said adapter [see Abstract], said contact pins having an adjustable spacing distance there between [adj. spacing between 142 of 141A and 141B using 145]; and

an adjustment device [71-75, 143 and using 141AX-Z and 141BXX-Z] configured to adjust said probe head relative to said holder.

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Regarding claim 2, Nishikawa discloses: The apparatus according to claim 1, wherein said at least one probe head is one of a plurality of probe heads [141A-B of 4D].

Regarding claim 3, Nishikawa discloses: The apparatus according to claim 1, wherein said probe head is movably disposed in elevation perpendicularly to a surface of said holder [see fig. 12-13].

Regarding claim 4, Nishikawa discloses: The apparatus according to claim 1, wherein said adjustment device is a robot arm [143, 141F and 141AX-Z] and said probe head is mounted on said robot arm [via 141AX-Z].

Regarding claim 6, Nishikawa discloses the holder is configured to hold test adapters with different diameters [inherent to variety of types of circuit board 2 as further defined at lines 26-29 of column 11].

Regarding claim 8, Nishikawa discloses: The apparatus according to claim 1, which comprises a control device [71, 73 and lines 66-61 of column 11] connected for controlling a distance between said contact pins.

Regarding claim 10, Nishikawa discloses: The apparatus according to claim 1, wherein the test adapter is a test card [2].

Regarding claim 17, Nishikawa discloses: The apparatus according to claim 1, wherein said holder is configured to be rotatable or movable [in y-direction using 63, 62, 62, 61, 6 and 5] with respect to said adjustment device.

Regarding claim 18, Nishikawa discloses: The apparatus according to claim 1, wherein said probe head is adjustable within a coordinate system selected from the

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group consisting of a polar coordinate system and a cartesian coordinate system  
[inherent to program stored in ROM of CPU and CAD].

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa as applied to claim 1 above, and further in view of Deckert et al. (US 6137303).

Regarding claim 5, Nishikawa discloses all the elements including a control device [71 and 73] to control a position of said probe head and the holder. Nishikawa does not disclose said control device [71, 73] controls a **rotation** of said holder. Rather, Nishikawa's control device [71 and 73] controls the movement of the holder in Y direction. Deckert et al. (hereafter Deckert) in fig.1 discloses **control device [25, 24, 20] to control a rotation** [see arrows in fig. 2] of a holder [21,23,32]. It would have been an obvious to a person having ordinary skill in the art at the time the invention was made to modify the apparatus of Nishikawa with rotational holder and control device as taught by Deckert, so the testing device (wafer or DUT) of the holder can controllably moved between different stations (e.g. testing, inspecting, marking) during test device (semiconductor or wafer or DUT) test operating process as taught by Deckert.

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Regarding claim 7, Nishikawa discloses all the elements except for stepping motor. However, Nishikawa discloses motor 63 but silent about stepping nature of it. Deckert discloses stepping motor [132, 133 (not shown), lines 7-18 of column 9] to position heads 26, 27 over the wafer. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the motor of Nishikawa with stepper motor as taught by Deckert, in order to rotate the holder with microscopic tolerances, in micron sized increments, in the horizontal plane with said probe heads during test operating process.

Regarding claim 9, Nishikawa discloses: The apparatus according to claim 7, which comprises a control device [71 and lines 34-41 of column 7] connected to said stepping motor [71 and lines 1-8 of column 5] and wherein said stepping motor is controlled by said control device.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa as applied to claim 1 above, and further in view of Vinson et al. (PCT/GB98/03262).

Regarding claim 11, Nishikawa discloses all the elements including the test adapter is formed with a number of contact surfaces [contacts of 2] one behind the other in a radial direction of the test adapter. Nishikawa does not disclose said **probe head has a number of said contact pins corresponding to the number of contact surfaces on the test adapter**. Vinson et al. (hereinafter Vinson) discloses probe head [10] has a number of said contact pins [probe of fig. 2-4 with different arrangement as shown in fig. 5-7] corresponding to the number of contact surfaces on the test adapter.



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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify apparatus of Nishikawa with probes of Vinson, in order to reduce testing time of each test adapter (or DUT), thereby increasing throughput.

6. Claims 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. as applied to claim 1 above, and further in view of Vinh (US 5952843).

Regarding claims 12 and 14, Nishikawa discloses all the elements except for **said contact pins are formed with pointed ends (claim 12), are spring-biased contact pins (claim 14).**

Vinh in fig.1A-B discloses **contact pins [1] are formed with pointed ends [7, lines 15-17 of column 8] and are spring-biased contact pins [1].**

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the pins of Nishikawa as taught by Vinh, in order to ensure good electrical contact with circuit under test (wafer or DUT) by providing pre-determined stress-strain profile from the shape of the spring of the probe pin.

Regarding claim 15, Vinh discloses **contact pins have a profile defining the spring-biased configuration [end of 2 towards 4] thereof.**

Regarding claim 16, Vinh discloses **contact pins have a separate spring [5 or 9].**

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa as applied to claim 1 above, and further in view of Barker (GB 2 240 435 A).

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Regarding claim 19, Nishikawa discloses all the elements except for an interface board disposed relative to said holder and opposite to said probe head, said interface board having contact pins configured to contact contact surfaces on the test adapter. Barker in fig. 3-4 discloses an interface board [10] with a contact pins [11] to contact contact surfaces on the test adapter [15]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Nishikawa with interface board of Barker, in order to make electrical contact between probe head and test equipment (ATE) during testing of test adapter (or interface fixture used for testing PCB).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paresh Patel whose telephone number is 571-272-1968.

The examiner can normally be reached on 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paresh Patel  
July 07, 2004

*David A. Zarnke*  
David A. Zarnke  
Primary Examiner  
7/9/04